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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,280	02/01/2002	Taku Yokoyama	450101-02920	3537

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,280

Applicant(s)

YOKOYAMA, TAKU

Examiner

Dennis Ruhl

Art Unit

3629

MLY

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Claims 1-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/28/03.
2. The abstract of the disclosure is objected to because it reads like claim. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 17, with respect to the language "inheritance information of a self-controlling type **robots**", is there one robot (arobots?) or more than one (robots)? What is meant by the language "on the on-line"? The preamble states "An on-line sales system" and this is understood to mean an Internet type of system but it is not known

what the on-line refers to? Is this a system or what? There is no antecedent basis for "said registered robots".

For claim 22, the language "an said second terminal" is confusing. Is "an" supposed to be "and"? The examiner is not clear as to what is being claimed here. What is the registration means in a structural sense? It is not clear what device on the disclosed invention performs the function of "setting inherent ID information to said first terminal an said 2nd terminal". What is meant by "setting" inherent information? Is this a transmission of information? The scope of this claim is not clear and it is considered indefinite. The claim will be examined in view of prior art as the claim is best understood by the examiner.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 17,19-23,25, are rejected under 35 U.S.C. 102(e) as being anticipated by Gabai et al. (6160986). Gabai discloses an online system for the downloading of robot personality type data. See col. 11, lines 8-20. The 1st terminal is considered inherent to Gabai because the robot data saved on the remote server has to get on the server by a 1st terminal (it has to be put on the server and saved initially) so the 2nd terminal 60 can

download the data from the server. With respect to the intended use of the device such as it being for a "sale" of data, describing a type of purchase, and for storing specific type of data, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (which in the instant case Gabai is fully capable of the intended use limitations) then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadakuni (6594649).

9. For claims 17,18,20,21,23,25, Sadakuni discloses a robot device that has personality data downloaded into the device from an external device such as a remote computer (registration means of claim 25). In column 13, lines 1-32, Sadakuni discloses that robot personality data can be downloaded (to a 2nd terminal) to the robot device from the Internet (Internet is the sales means of claim 25). Sadakuni discloses

that by having the ability to get data from the Internet, data from multiple devices can be cross bred (mating means) to create a new system with a new personality. This cross breeding inherently requires uploading of robot data from a 1st terminal to put the data on the Internet so it can be cross bred. Sadakuni does not disclose a "server". It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a server in the system of Sadakuni so that the robot data can be stored and accessed via the Internet. The use of a server to manage and store data on the Internet is well known and obvious to one of ordinary skill in the art. With respect to the intended use of the device such as it being for a "sale" of data, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (which in the instant case is fully capable of the intended use limitations) then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

For claim 19, Sadakuni discloses a recordable medium in column 13.

For claim 22, the registration means is considered to be present in Sadakuni.

For claim 24, Sadakuni discloses the invention substantially as claimed.

Sadakuni discloses that robot personality data can be stored for downloading on/from the Internet. This satisfies the claimed registration step of registering inheritance information on-line. Sadakuni does not disclose the "selling" of the robot personality

data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to sell the robot data so that one can make money. Prior to the filing date of this application it was in the public domain that various companies are selling robots for personal use where the robots possess a personality determined by personality data. In view of this fact and in view of the fact that one can find just about everything for sale nowadays the concept of "selling" robot personality data (noting that robots that use the data are already being sold in the retail marketplace) is considered obvious to one of ordinary skill in the art.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rheey (2002/0094851), Gabai et al. (2001/0031652 and 2001/0021669) disclose robots that use personality data. The following articles are also being cited as being relevant to the claimed invention: "Entertainment robot is more byte than bark", "Pet robots considered therapy for elderly", NEC shows off consumer robot", Sony unveils prototype humanoid robot", "Sony unveils new robotic pet", "Internet Product Watch: irobot-LE (Browser controlled Linux-based robot), and "More pet robots on the way".

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER